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Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents.

See attached.

SUPPLEMENTAL
Office Action Summary

Application No.
08/243,638

Applicant(s)
Daniel H. Abelow

Examiner
Steven R. Yount

Group Art Unit
2411



☒ Responsive to communication(s) filed on May 16, 1994

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-47 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-47 is/are rejected.

☒ Claim(s) 1, 14, and 17 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☒ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Part III DETAILED ACTION

Specification

1. The specification is objected to as failing to provide clear support for the claim terminology. 37 CFR § 1.75(d)(1) requires that terms and phrases used in the claims find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. Specifically, the following terms do not appear in the specification.

A. In claim 1, "local information," product information" and "means for taking action."

For purposes of applying prior art, these terms are interpreted in accordance with the explanations provided by Applicant's representative in the March 15, 1996 telephone interview. "Local information" is interpreted as any information relating to a user's use of a product and is exchanged between the user and the product. "Product information" is interpreted as information which could comprise local information, analyzed or processed local information or other information related to the product. "Means for taking action" is interpreted as a means which does something in response to the product information.

B. In claim 3, "means for controlling the taking of action." For purposes of applying prior art, this term is interpreted in accordance with the explanations provided by Applicant's representative in the March 15, 1996 telephone interview. "Means for controlling the taking of action" is interpreted as a means which controls the means for taking action based on the results of the analyzer's analysis of the product information.

C. In claim 4 "new interface elements." For purposes of applying prior art, this term is interpreted in accordance with the explanations provided by Applicant's representative in the March 15, 1996 telephone interview. "New interface elements" in claim 4 is interpreted as additional local information which can be exchanged between the product and the user.

D. In claim 5, "product module." For purposes of applying prior art, this term is interpreted in accordance with the explanations provided by Applicant's representative in the March 15, 1996 telephone interview. The "product module" in claim 5 is interpreted as the customer based product design module (CB-PD module) disclosed in the specification at page 35.

E. In claim 23, "user feedback element." For purposes of applying prior art "user feedback element" in claim 23 is interpreted as any means for accumulating information on use of the product by the user.

Claim Objections

2. Claims 1, 14 and 17 are objected to because of the following informalities.

There is a superfluous "for" in line 9 of claim 1; there appears to be a superfluous "keyboard" in claim 14 and the word "for" in line 2 of claim 17 appears to be a typo and should be deleted.

Claim Rejections - 35 USC § 112

3. Claims 1, 3, 4, 5 and 23 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.
4. Claims 2 -42 are rejected because they depend from rejected base claims.
5. Claims 21, 32 and 35 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

In claim 21, the functional recitation that "the user is enabled to ..." is indefinite because it is not supported by recitation in the claim of sufficient structure to accomplish the function.

In claim 32, it is not clear what is meant by "transactions performed by the user." It is not clear if this is intended to be limited to business transactions or transactions in general. *Webster's II New Riverside Dictionary* defines transact as "To do, perform, carry out or conduct." In claim 32 "transactions performed by the user" is interpreted as tasks or operations performed by the user.

In claim 35, "the user interface" is referred to but has not been previously recited. For purposes of applying prior art, it assumed that the "user feedback element" was intended. Also in claim 35, it is not clear what is meant by "enabling the user to set a priority for response to information entered by the user via the user interface." It is not clear what aspect of the response is being prioritized. Is it the time of the response in relation to the time of other responses? Or is it prioritizing the information entered by the user? For purposes of

applying prior art, it assumed that the priority in claim 35 corresponds to page 91 of the specification, lines 1-3, wherein the user rates the questions they are responding to.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

7. Claims 1-36 and 39-42 are rejected under 35 U.S.C. § 103 as being unpatentable over Mantel et al.

A. As to claim 1, Mantel discloses a system for use with a product (a product development system). An associated user interface is disclosed at page 267, col. 2, fourth paragraph, lines 1-3 (i.e. the keyboard and monitor of the computer on which the software product is being run and which is used to respond to the on-line test¹). Communication of local information concerning use of the product is disclosed at page 268, col. 1, lines 1-4 (i.e. the user's responses to the on-line test).

i. Mantel differs from Applicant's invention in that Mantel does not disclose *bi-directional* communication of local information (i.e. the questions to which the user responds are a set of written questions rather than displayed on the user interface); does not specifically disclose that product information is communicated between the product and a remote party;

and does not specifically disclose a means for taking action, with respect to the product or the user interface, based on the product information.

ii. As to the first difference, it would have been obvious to one skilled in the art to incorporate an electronically displayed set of questions into the data gathering procedure. Electronic displays of survey and other questions are well-known in the art, particularly in situations where the respondent is to respond electronically. For example, the questions to which one responds in using an ATM machine. One would have been motivated to display the questions electronically to avoid the costs of printing sets of paper questions and to avoid the possibility of not having enough sets of questions for all users.

iii. As to the second and third differences, Mantel does disclose that a log of the user responses is kept and analyzed. The Mantel article generally concerns designing and redesigning products based on information gathered concerning users' use of the product. It would have been obvious to one skilled in the art to communicate the product information to the manufacturers of the product (a remote party) so that they could redesign the product. It also would have been obvious to include a means for redesigning (means for taking action with respect to the product) so that the product could be redesigned. The primary reason for collecting information in Mantel is to communicate it to a remote party so that action can be taken.

B. As to claim 2, Mantel differs from Applicant's invention in that Mantel does not specifically disclose an authoring system. However, Mantel does disclose that the user tests are "*designed* to examine what the user has learned about the system" (emphasis

supplied). It would have been obvious to one of ordinary skill in the art to include an authoring system to aid in designing the user tests so that the content of the tests could be updated from time to time to reflect changes to the product in the redesign stages. Someone or something has to manage and write the tests and surveys used in Mantel. An authoring system would naturally be used to do this.

C. As to claim 3, Mantel differs from Applicant's invention in that Mantel does not specifically disclose that the means for taking action is responsive to the results of an analyzer. However, as discussed above, the product information in Mantel is analyzed. Thus, it would have been obvious to include an analyzer. Further, it is implicit in the system of Mantel that the redesigning of the product is in response to analysis of the collected information. *See e.g.*, Fig. 1, which is a flow chart of the product development life cycle.

D. As to claim 4, changing the content of the information collected has been discussed above in paragraph B.

E. As to claim 5, as discussed above, the "product module" is interpreted as corresponding to the CB-PD module disclosed in the specification. At page 43, lines 8-11, the specification discloses that the CB-PD module may be built into the product using features of the product. The features built into the product in Mantel (and those which it has been argued would have been obvious to include), which perform the claimed functions discussed above in paragraph A, corresponding to the CB-PD module. Further, it would have been obvious to one skilled in the art to allow for selective disabling and enabling of the module. In Mantel, sometimes the users are using the product and at other times they are

answering questions (using the CB-PD module). This would not be possible without selective disabling and enabling of the module.

F. As to claim 6, Mantel differs from Applicant's invention in that Mantel does not specifically disclose that the CB-PD module may be enabled in response to a trigger event. However, it would have been obvious to one of ordinary skill in the art to include this feature. Whatever is done to enable the module (e.g. clicking on an icon with a mouse or a keystroke combination) would be a trigger event.

G. As to claim 7, initiation of the trigger event at the product is discussed above in the rejection of claim 6.

H. As to claim 8, Mantel differs from Applicant's invention in that Mantel does not disclose that the trigger event is initiated by a remote party other than the user. In Mantel, the personnel administering the system are remote parties other than the user. It is these remote parties who hand out the questionnaires and tests and initiate other aspects of the system. *See e.g.*, pages 267-268. If the questions were presented electronically, as discussed above in paragraph A, it would have been obvious to one skilled in the art to display them upon initiation of a trigger event by the remote party. One would be motivated to do so in order to coordinate the timing of the tests or to assure that all users successfully entered "test mode." Further, the simple announcement "everyone please change over to test mode" would constitute "initiation" by a remote party.

I. As to claim 9, the local information in Mantel is generated during use of the product. *See e.g.*, page 268, col. 1, lines 1-4.

J. As to claim 10, communication of queries during use of the product is addressed above in paragraphs A and I.

K. As to claim 11, the queries in Mantel concern use of the product. *See e.g.*,

L. As to claim 12, Mantel discloses that answers to the queries are stored in the product at page 268, col. 1, lines 4-6. page 268, col. 1, lines 1-4.

M. As to claim 13, the module in Mantel comprises hardware and software.

N. As to claim 14, the user interface in Mantel comprises a keyboard and display screen.

O. As to claim 15, changing the interactions permitted by the user is discussed above in paragraph B.

P. As to claim 16, Mantel differs from Applicant's invention in that Mantel does not disclose that communication between the product and the remote party is by broadcast transmission, wire or removable memory device. Mantel does disclose that a log of responses is kept and later analyzed, but does not disclose how this information is communicated to the remote party. It would have been obvious to one skilled in the art to use any of these means because they are all old and well known. Also, storing the information on a floppy disk , removing it and delivering it to the remote party would be particularly easy to carry out, as it would not require any special additional communications equipment.

Q. As to claim 18, the system in Mantel contemplates multiple users. *See e.g.*, page 267 col. 2, third full paragraph. Mantel differs from Applicant's invention in that Mantel does not disclose that the analyzer analyzes product information for multiple products.

However, it would have been obvious to one skilled in the art to analyze product information for multiple products on the analyzer. If the remote party were a manufacturer of multiple products and employed a computer to analyze the product information, they would be motivated to use the computer to analyze information from more than one product in order to avoid buying a separate computer for each product. Mantel contemplates that manufacturers may have more than one product at page 270, paragraph 2.

R. As to claims 18 and 19, user interfaces in multiple natural languages are well known in the art. For example, ATM machines presenting questions in multiple languages have been around since at least the late 1980's. One would have been motivated to use such an interface since not all persons speak the same language.

S. As to claims 20, 21 and 22, selective control of enabling and disabling of the interface at the module has been discussed above in paragraph G. This would allow the user to control communication with the product and to control enabling and disabling of the interface.

T. As to claim 23, Mantel generally discloses a method for aiding design of a product. As noted above, the "user feedback element" is interpreted as any means for accumulating information on use of the product by the user. Mantel discloses a user feedback element at page 267 col. 2 (the user interface discussed in the rejection of claim 1) and at pages 270 to 271 (the product survey). Recovering information from user feedback elements is disclosed at page 272, col. 2, fourth paragraph and at page 267, col. 2, 2nd and 3rd

paragraphs. Creating a first version of the product, analyzing information and redesigning the product are discussed above in paragraphs A(iii) and C.

Mantel differs from Applicant's invention in that Mantel does not disclose that the user feedback element (survey) is included with the product. The user survey in Mantel is mailed to the user after purchase of the product. However, it had been a common practice for some time, at the time of the invention, to include user surveys with products. One skilled in the art would have been motivated to include the surveys with the products in order to ensure that the surveys actually get to the users since surveys mailed after purchase may be lost in the mail or sent to an old address.

U. As to claim 24, Mantel discloses that information recovered from the user feedback element includes information provided by the user with respect to problems in use of the product at page 271, col. 1, 1st paragraph, last sentence.

V. As to claims 25 and 26, and 34, Mantel discloses that information recovered from the user feedback element includes information provided by the user with respect to solutions to problems (i.e. improvements) in use of the product and usability of the product at page 271, col. 1, 4th paragraph.

X. As to claims 27 and 28, recovery of such information in market surveys was common and well established at the time of the invention.

Y. As to claim 29, Mantel differs from Applicant's invention in that Mantel does not specifically disclose that the information contains information about business processes using the product. The product, used as an example in Mantel, is a data base management

system. However, it would have been obvious to one of ordinary skill in the art that the system in Mantel is equally applicable to any type of software product, such as financial or accounting software. *See* page 260, col. 2. In this case, the information would contain information about business processes using the product.

Z. As to claims 30, 31 and 32, Mantel discloses that information recovered from the user interface includes analysis of tasks performed by the user with the product, analysis of performance of the user with the product, and transactions performed by the user with the product at page 267, col. 1, 3rd paragraph, lines 4-9 and page 267, col. 2, 3rd and 4th paragraphs.

AA. As to claim 33, Mantel discloses that the information may include user suggested expansion of business relationships at page 260, col. 2, 3rd paragraph, last sentence.

BB. As to claim 35, Mantel differs from Applicant's invention in that Mantel does not disclose enabling the user to set a priority for response to information entered by the user via the user interface. However, it would have been obvious to one of ordinary skill in the art to allow the users to rate the importance of the questions because a manufacturer collecting user information geared toward redesigning a product would want to know not only if the user thought a particular feature worked well, but also if they thought the feature was important.

CC. As to claim 36, the information recovered in Mantel includes information developed in the course of interactive learning by the user. The product in Mantel is an

interactive product and the user tests recover information developed in the course of interactive learning by the user.

DD. As to claim 39-41, buying, selling and sharing marketing information and compensating survey participants were all well known in the art at the time of the invention.

EE. As to claim 42, Mantel differs from Applicant's invention in that Mantel does not disclose giving access to the feedback element to a third party. However, there are common and foreseeable situations where it would be obvious to one of ordinary skill in the art to do so. For example, If the feedback element or product were to malfunction or become damaged, it would be obvious to take it to a repair shop (third person) so that product design could continue.

8. Claims 37 and 38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mantel, as applied to claim 1 above, and further in view of *Microsoft Press Computer Dictionary*, page 41, definition of "beta testing."

A. As to claim 37, Mantel differs from Applicant's invention in that Mantel does not disclose running user tests of information recovered from the user feedback element. According to the definition, beta testing is a process of soliciting feedback from users of a product which is still under development and changing the design of the product based on the results of information gathered from users. The system in Mantel is essentially the same process and is carried out for the same reasons. Thus, one skilled in the art, implementing the system of Mantel, would be aware of and motivated to employ other standard beta testing methodology. According to the definition, sometimes there are two cycles of beta testing. In

the second round of user testing, users would be testing user information recovered from the user feedback element in the first round and incorporated into the proposed redesign.

B. As to claim 38, the definition of beta testing discloses recovering information from users about their use of proposed redesigns. Further, it would have been obvious to one skilled in the art to include questions about proposed a proposed redesign in the user surveys because the purpose of the surveys is to end up with a design that reflects user preferences.

9. Claims 43-46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over "America Online Expands Internet Access" (AOEIA).

A. Claim 43 reads on Internet provider services such as CompuServe and America Online (AOL), described in the AOEIA article, which have been around since at least the late 1980's. These services deliver product information concerning use of the product (the product being Internet access) from remote locations (e.g. from newsgroups or from the service provider) to the users through a user interface. For example, the Internet Center by AOL, discussed in the AOEIA article, provides such information. The user interface could be interpreted either as the keyboard and monitor of the user's computer system or the service provider's software responsible for the graphical or other interface by which the user interacts with the system. In any event, a user interface is clearly inherent in these systems.

B. As to claims 44 and 45, it would have been obvious to one skilled in the art to provide sales and marketing information through the user interface in order to alert

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subscribers to new services and to attempt to prevent subscribers from switching to other Internet access providers.

C. As to claims 46 and 47, Mantel discloses that the information may include customer service information, including training information (information designed to educate consumers) at lines 5-8.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven R. Yount whose telephone number is (703) 306-2906. The examiner can normally be reached on Monday through Thursday and every other Friday from 8:00 AM to 5:00 PM.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gail Hayes, can be reached at (703) 305-9711. The fax phone number for this Group is (703) 305-9731.

12. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose phone number is (703) 305-3800.

S. Y.

Steven R. Yount
May 14, 1996


ROBERT A. WEINHARDT
PRIMARY EXAMINER
GROUP 2400